

REMARKS

This amendment is in response to the Final Office Action mailed October 18, 2006. Claims 1-13, 36, 39, 48, and 49 have been amended and claims 51 and 52 are new. Claims 1-52 are presently pending. No new matter has been added.

Withdrawal of the Finality of the Office Action

The Applicant thanks the Examiner for the telephone interview on November 13, 2006 with the Applicant's representative. During the telephone interview, claims 42-44 were discussed. The earlier rejection of these claims was withdrawn because the Sheedy reference was removed from consideration under 35 U.S.C. § 103(c) (because Sheedy and the present application were both owned or subject to assignment to the same assignee at the time the invention was made) and the claims were not amended. In the present Office Action, a new rejection of claims 42-44 was asserted. In view of these circumstances and M.P.E.P. § 706.07(a), the present Office Action should be non-final. The Examiner agreed to withdraw the finality of the present Office Action in the telephone interview and the subsequent Interview Summary mailed 11/22/06.

The Applicant further notes that a similar situation occurs with the present Office Action and the present Amendment. In this instance, claim 24 is rejected under 35 U.S.C. §103 over Takahashi and Hidary in view of U.S. Patent Application Publication No. 2002/0083464 to Tomsen et al. ("Tomsen"). Tomsen and the present application were both owned, or subject to assignment, to Digeo Inc. at the time the present invention was made. Therefore, under 35 U.S.C. §103(c) Tomsen is unavailable for the present rejection of claim 24. Accordingly, the next Office Action, if one is mailed, should also be non-final.

§112 Rejection

Claim 1 was rejected under 35 U.S.C. § 112, first paragraph for failing to comply with the written description requirement. The Applicant has amended claim 1 to refer to a client terminal instead of a display. The Applicant respectfully requests withdrawal of this rejection.

§103 Rejections

Claims 1, 4, 5, 7, 9-15, 20, 27, 28, 34, 48, and 50 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,308,329 to Takahashi ("Takahashi") in view of U.S. Patent No. 5,778,181 to Hidary et al. ("Hidary"). Claims 36, 39 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi in view of Hidary, U.S. Patent No. 6,628,302 to White et al. ("White 1"), and U.S. Patent No. 5,657,072 to Aristides et al. ("Aristides"). Claims 2 and 3 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent No. 5,764,734 to Medendorp et al. ("Medendorp"). Claim 16 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent No. 5,648,813 to Tanigawa et al. ("Tanigawa"). Claims 17 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent No. 6,392,664 to White et al. ("White 2"). Claim 18 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi, Hidary, and White in view of U.S. Patent No. 6,928,087 to Slowe et al. ("Slowe"). Claims 21-23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent No. 4,510,623 to Bonneau et al. ("Bonneau"). Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent Application Publication No. 2002/0083464 to Tomsen et al. ("Tomsen"). Claims 37 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi, Hidary, White and Aristides in further view of Bonneau. Claim 41 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi, Hidary, and Aristides in further view of U.S. Patent No. 6,380,984 to Inoue et al. ("Inoue"). Claims 6, 25, and 29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent No. 5,495,283 to Cowe ("Cowe"). Claim 8 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent No. 5,761,650 to Munsil et al. ("Munsil"). Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi, Hidary, and Cowe in further view of U.S. Patent No. 5,760,820 to Eda et al. ("Eda"). Claims 30-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent No. 6,222,947 to Koba ("Koba"). Claim 35 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of U.S. Patent No. 6,903,779 to Dyer. ("Dyer"). Claims 42 and 43 were rejected

under 35 U.S.C. §103(a) as being unpatentable over Takahashi in view of U.S. Patent No. 6,154,772 to Dunn et al. (“Dunn”). Claim 44 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Dunn in view of Cowe. Claims 45-47 were rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Dunn in view of White 2. (“Dyer”). Claim 49 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi and Hidary in view of White. The Applicant traverses these rejections.

As an initial matter regarding claim 24, the present application (Serial No. 10/033,365) and Tomsen (U.S. Patent Application Publication No. 2002/0083464) were, at the time the invention of the present application was made, owned by Digeo Inc. Accordingly, under 35 U.S.C. §103(c) Tomsen is not available for a rejection of claim 24 under 35 U.S.C. §103(a). For at least this reason, claim 24 is patentable. The Applicant respectfully requests withdrawal of the rejection of claim 24.

Claims 1, 14, and 27 each recite two tuners where the first tuner receives a television broadcast signal and the second tuner receives data related to an event resulting in display of indicia indicative of the event on a display screen of a client terminal in response to a trigger detected using the first tuner. The Office Action acknowledges that Takahashi does not teach two tuners. (See, e.g., Office Action, pp. 3-4.) Hidary discloses a computer that can display television broadcasts and also receive URLs with the broadcast and display the web sites corresponding to the URLs. The Office Action suggests the combination of Hidary with Takahashi. The Office Action ignores, however, that Takahashi teaches away from the proposed combination of the device of Takahashi with the computer functions of Hidary. (Takahashi, Col. 2:22-25; 1:57-2:7; and 5:10-16.) Takahashi specifically teaches a stand-alone unit that is not communicatively coupled to a computer. One of ordinary skill in the art would not turn to Hidary to modify Takahashi because Takahashi is specifically teaching away from including computer-like functions to avoid needing to boot up a personal computer to receive push type data. (Takahashi, Col. 2:22.) As indicated in M.P.E.P. §2141.03 “Prior art must be considered in its entirety, including disclosures that teach away from the claims.” In this case, Takahashi clearly teaches away from the proposed combination with Hidary.

None of the other references address these deficiencies of Takahashi and Hidary. For at least these reasons, claims 1, 14, and 27, as well as claims 2-13, 15-26, 28-35, 51, and 52 which depend therefrom, are patentable over the cited references. The Applicant respectfully requests withdrawal of the rejections of these claims.

Independent claims 42 and 45 each recite a client terminal coupled to a display area. The client terminal causes presentation of information (e.g., a television program) on a television screen and also displays screen indicia on the display area. These claims are rejected over the combination of Takahashi and Dunn. Again, as explained above Takahashi teaches a stand-alone device and teaches away from communicatively coupling the device to a television or computer. None of the other references address these deficiencies of Takahashi and Dunn. For at least these reasons, claims 42 and 45, as well as claims 43, 44, 46, and 47 which depend therefrom, are patentable over the cited references. The Applicant respectfully requests withdrawal of the rejections of these claims.

Independent claim 35 recites a display screen of a client terminal that is capable to present menu selections for a television at least alternatively to presentation of the menu selections on a screen of the television. None of the cited references teach or suggest this element. In particular, Takahashi does not teach or suggest communicatively coupling the Takahashi device to a television. Accordingly, the Takahashi device can not receive information from the television to display television menu selections. None of the other references address these deficiencies of Takahashi. For at least these reasons, claim 36, as well as claims 37 and 38 which depend therefrom, are patentable over the cited references. The Applicant respectfully requests withdrawal of the rejections of these claims.

Independent claims 39 and 48 recite generating an interactive icon on a television for an event and, if the icon is selected, providing information about the event on a display of a client terminal. None of the cited references teach or suggest this element. In particular, Takahashi does not teach or suggest communicatively coupling the Takahashi device to a television. Accordingly, the Takahashi device does not detect, or otherwise determine, the selection of an interactive icon.

None of the other references address this deficiency of Takahashi. For at least these reasons, claims 39 and 48, as well as claims 40, 41, 49, and 50 which depend therefrom, are patentable over the cited references. The Applicant respectfully requests withdrawal of the rejections of these claims.

The dependent claims include additional patentable features. For example, claim 4 recites that the screen indicia are simultaneously displayed via the television and the display screen. The Applicant respectfully submits that one of ordinary skill in the art would understand that “displayed via the television” means displayed on the screen of the television and not, as the Office Action suggests, attachment to the chassis of the television. Nevertheless, to assist in prosecution, claim 4 has been amended to recite that the screen indicia is displayed via the screen of the television. This amendment is not meant to narrow the claim but rather to clarify what is implicitly understood. None of the cited references teach or suggest the elements of claim 4. For at least these additional reasons, claim 4 is patentable over the cited references. The Applicant respectfully requests withdrawal of the rejections of this claim.

Claim 8 recites displaying a combination of dynamic and static text. The Office Action acknowledges that Takahashi and Hidary do not teach or suggest this element. (Office Action, p. 20.) The Office Action cites Munsil. Munsil, however, is directed to bill editing software. One of ordinary skill in the art would not look to Munsil to modify Takahashi and Hidary because Munsil is directed to a very different application that has no particular relevance to the information display devices and systems of Takahashi and Hidary. Accordingly, there is no motivation to combine Munsil with Takahashi and Hidary. The present rejection involves “picking and choosing” elements from individual references with disregard for the full context of the references. For at least these additional reasons, claim 8 is patentable over the cited references. The Applicant respectfully requests withdrawal of the rejections of this claim.

Claim 23 is directed to presenting indicia of an event sequentially with indicia of an operational feature of the client terminal and claim 38 is directed to displaying indicia of the operational features alternately with indicia of events. None of the cited references teach or suggest this sequential or alternating display of indicia. The Office Action cites Bonneau for teaching the

presentation of an operational feature such as a channel number. There is no teaching or suggestion in Bonneau or any of the other cited references that the indicia of an event is presented sequentially or alternately with indicia of an operational feature. Bonneau does not teach or suggest such sequential or alternating presentation and neither do Takahashi or Hidary. In particular, none of these references teach presentation of both types of indicia recited in claims 23 and 38 and, therefore, none of the references teach or suggest the sequential or alternating arrangement of one type of indicia relative to the other type. Thus, the cited references do not teach or suggest every element of claims 23 and 38. For at least these additional reasons, claims 23 and 38 are patentable over the cited references. The Applicant respectfully requests withdrawal of the rejections of these claims.

Claim 35 recites that the dynamically received event includes closed captions. The Office Action acknowledges that Takahashi and Hidary fail to teach this element of the claims. (Office Action, p. 23.) The Office Action cites Dyer. At most, the combination of Dyer, Takahashi, and Hidary teaches presenting closed captions on the television or computer where the video presentation is presented. None of the cited references teach or suggest displaying closed captions on any device other than the computer or television upon which the corresponding video presentation is being displayed. There is no motivation in any of the references to display closed captions on a separate display. Moreover, since the Takahashi device is not communicatively coupled to the television the Takahashi device can not know what closed captions should be displayed because it can not know what television channel is being viewed.

The present invention is directed to displaying the closed captions on a different display from that upon which the video presentation is being displayed. This has the advantage of avoiding clutter and distractive material on the screen displaying the video presentation. None of the cited references teach or suggest this advantage. Accordingly, none of the cited references, alone or in combination, teach or suggest all of the elements of claim 35. For at least these additional reasons claim 35 is patentable over the cited references. The Applicant respectfully requests withdrawal of the rejections of this claim.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If the Examiner has any questions or concerns, the Applicant encourages the Examiner to contact the Applicant's representative, Bruce Black, by telephone to discuss the matter.

Dated: December 13, 2006

Respectfully submitted,

By B. E. Black

Bruce E. Black

Registration No.: 41,622

DARBY & DARBY P.C.

P.O. Box 5257

New York, New York 10150-5257

(206) 262-8908

(212) 527-7701 (Fax)

Attorneys/Agents For Applicant